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In the
Supreme Court of the United States
OCTOBER TERM 1957

No. 335

SOLAR CORPORATION, BY MERGER NOW GAMBLE-SKOGMO, INC.

Petitioner

vs.

BORG-WARNER CORPORATION

Respondent

PETITIONER'S REPLY BRIEF

TO THE UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

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This Brief is filed pursuant to Rule 24, par. 4, of the Rules of this Court, and the following observations are noted with respect to Respondent's Brief (Res. Br.) in Opposition to Petition for Writ of Certiorari.

1.

Respondent's argument (Res. Br. p. 4) that the "review sought—would in any event be futile" because "Petitioner does not challenge the finding of non-infringement" is erroneous. Certain claims were admittedly infringed. As to those held not infringed by the District Court, that issue was not considered by the Court of Appeals. In its Petition to this Court Petitioner expressly stated (pp. 9-10) that if

the Petition is granted a question to be determined is "(2) Are claims 4 and 5 of the original and claims 4, 5, 6, 7 and 8 of the reissue Castner patent infringed?" Thus, while the issue of infringement has not been argued, because it does not raise a jurisdictional question, it has decidedly not been left unchallenged.

2.

The argument that "Petitioner fails to point out to this Court, etc." (Res. Br. p. 5) what transpired in the Patent Office in connection with the reissue proceedings goes to the question of intervening rights and is equally erroneous. The question of intervening rights does not raise a jurisdictional issue, and, as noted in the Petition (p. 10)—"The issue of intervening rights will be resolved if claim 4 of the original Castner patent is held to be valid and, as with other collateral issues, need not be discussed unless and until this Petition is granted."

3.

Respondent's arguments (Res. Br. p. 5) that Petitioner's position with respect to interpretations of the Patent Act of 1952 "raises a wholly academic issue" are equally without merit. As noted in the Petition (p. 7) it was Respondent itself who first raised the question as to whether or not the 1952 Patent Act lowered the then existing severe standard of invention laid down in earlier court decisions. And the fact that the lower courts in this case chose to ignore the great confusion that has since developed, by the more recent and conflicting interpretations of the Act, certainly does not deprive Petitioner of this opportunity to bring that important issue before this Court for final determination.

4.

Significantly Respondent (1) does not deny the existence of confusion now prevailing with reference to interpretation of the 1952 Patent Act, (2) does not challenge this Court's authority to resolve that confusion, (3) does not distinguish or even discuss the several authorities cited by Petitioner, and (4) does not cite a single decision in support of its own position.

5.

The Questions Presented (Pet. p. 3) by this Petition raise critically important issues that should be judicially terminated by this Court.

Respectfully submitted,

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September 6, 1957